

BARNES & THORNBURG LLP

11 South Meridian Street
Indianapolis, Indiana 46204
(317) 236-1313
(317) 231-7433 Fax

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

<i>Customer No.</i> :	23643	}
<i>Group:</i>	3621	}
<i>Confirmation No.:</i>	6871	}
<i>Application No.:</i>	09/900,989	}
<i>Invention:</i>	WASTE PROCESSING SYSTEM AND METHOD	}
<i>Inventor:</i>	Kenneth S. Price et al.	}
<i>Filed:</i>	July 9, 2001	}
<i>Attorney</i>		
<i>Docket:</i>	41898-79395	}
<i>Examiner:</i>	James A. Reagan	}

FILED ELECTRONICALLY
APRIL 2, 2007

APPEAL BRIEF

Mail Stop Appeal Brief - Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is submitted electronically for the application identified above in support of the appeal from the October 17, 2005 rejection of claims 22-54. This Appeal Brief is being filed contemporaneously with a Petition for Revival Under 37 C.F.R. 1.137(b) to revive the abandoned application. Appellants hereby authorize the Commissioner to charge the \$500 Appeal Brief filing fee, as well as any additional fees that may be due in connection with this

Appeal Brief, to Deposit Account No. 10-0435, with reference to our attorney docket number 41898-79395.

REAL PARTY IN INTEREST

The real party in interest is Heritage Interactive Services, LLC, the assignee, pursuant to an assignment recorded in the records of the U.S. Patent and Trademark Office at reel 017288, beginning at frame 0184.

RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellants that will directly affect or be directly affected by, or have a bearing on the Board's decision in the present appeal.

STATUS OF CLAIMS

Claims 22-54 were rejected in the Office Action dated October 17, 2005. Each of the claims 22-42 and 49-52 having been twice rejected, is appealed under 37 CFR 41.31(a)(2). None of the remaining claims 43-48 and 53-54 are the subject of this appeal, and these claims will be cancelled by Appellants pending the outcome of this appeal.

A copy of appealed claims 22-42 and 49-52 is attached hereto in an Appendix.

STATUS OF AMENDMENTS

No amendment has been filed subsequent to the rejection of October 17, 2005.

SUMMARY OF CLAIMED SUBJECT MATTER

Independent Claim 22:

Independent claim 22 is directed to a waste management system (10) comprising a computer storage medium storing waste management data (110) associated with a plurality of vendors (40, 60, 80) having waste management capabilities and providing waste management services and entity profile data (120) associated with a plurality of waste producing entities (20, 30) having waste processing requirements and producing waste components, and a first computer system configured to access the computer storage medium and stored waste management data (110) and entity profile data (120), and further configured to associate a set of vendors (40, 60, 80) from the plurality of vendors to provide waste management service for the waste producing entity (20, 30). The system of claim 22 is shown diagrammatically in Fig. 2. The discussion at pg. 9, l. 10 to pg. 10, l. 12 of the specification also facilitates an understanding of claim 22.

Independent Claim 39:

Independent claim 39 is directed to a method of managing waste. The method includes the step of creating a service network (100) including a plurality of waste processing vendors (40, 60, 80). The method also includes the step (910) of evaluating the waste processing capabilities of each of the waste processing vendors (40, 60, 80) in the service network (100). The method further includes the step (1002) of receiving a waste processing service request from a waste producing entity (20, 30). The method still further includes the step (1004) of comparing the waste processing service request to the capabilities of the waste processing vendors (40, 60, 80) in the service network (100). The method also further includes the step (1006) of selecting a vendor (40, 60, 80) from the service network (100) to fulfill the waste processing service request.

The method of claim 39 is shown diagrammatically in Figs. 9 and 10A. The discussion at pg. 18, l. 11 to pg. 20, l. 8 of the specification also facilitates an understanding of claim 39.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The following ground of rejection is presented for review:

(1) the rejection of claims 22-42 and 49-52 under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 6,097,995 to Tipton et al. (hereinafter “Tipton”) in view of U.S. Patent No. 5,699,525 to Embutsu (hereinafter “Embutsu”).

ARGUMENT

I. The Board is Urged to Reverse the Ground of Rejection

The claims within the ground of rejection will be argued in the following groups:

Group A - claims 22 and 49-50

Group B- Claims 23-24, 32 and 27-29

Group C - Claims 25, 34-35, 39-42 and 51-52

Group D - Claims 26 and 33

Group E - Claims 30-31

Group F - Claim 36

Group G - Claims 37 and 38

A. *Claims 22 and 49-50 are not Obvious over Tipton and Embutsu*

The §103 rejection of claims 22 and 49-50 is improper and should be overruled for at least the following reasons:

(i) There is no Legally Sufficient Teaching, Motivation, or Suggestion to Combine the References

The rule of law for a finding of obviousness under 35 U.S.C. §103 was explained by the Court of Appeals for the Federal Circuit as follows, “[w]hen patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.” *In re Lee*, 277 F.3d 1338 at 1343, 61 U.S.P.Q. 2d 1430 (Fed. Cir. 2002); See also *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339 at 1351-52, 60 U.S.P.Q. 2d 1001 (Fed. Cir. 2001) (“the central question is whether there is reason to combine [the] references,” a question of fact drawing on the Graham factors). The Federal Circuit expounded upon the necessity of finding some teaching or motivation to combine the references in the references themselves concluding that “[t]he factual inquiry whether to combine references must be thorough and searching.” *In re Lee*, 61 U.S.P.Q. 2d at 1433 (Fed. Cir. 2002). The teaching or suggestion to make the claimed combination must be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q. 2d 1438 (Fed. Cir. 1991).

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

In this regard, the Examiner has not put forth a legally sufficient teaching, motivation, or suggestion in support of the proposed combination of Tipton and Embutsu. In particular, the Federal Circuit has long since maintained a necessity of finding some teaching or motivation to combine the references *in the prior art*, such as the references themselves, and not based on applicant's disclosure. The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done.

In an apparent attempt to establish a case of obviousness in the present case, the Examiner stated in the 10/17/2005 Official Action that “[i]t would have been obvious to combine the existing waste management systems as taught by Tipton and add the teaching to including the database matching techniques as shown by Embutsu because the resultant system would solve the problem of efficiently and cost-effectively matching waste producer with waste manager, improving upon the existing matching system of Tipton by more closely matching according to pre-selected criteria” (see page 3). This conclusory statement lacks any legally sufficient teaching, motivation, or suggestion to combine the teachings of Tipton and Embutsu in such a manner. Such an unsupported, conclusory statement offered by the Examiner is not a legally sufficient substitution for the factual analysis required by the Federal Circuit. The Examiner has failed to point to any section of Tipton, Embutsu or any other art of record wherein such teaching, motivation, or suggestion is provided.

Furthermore, not only has the Examiner not offered a legally sufficient teaching, motivation, or suggestion to combine the inventory management system of Tipton with the waste management system of Embutsu, it is believed that no such motivation exists. Even if one of ordinary skill in the art had the general desire to “improve upon the existing matching system of Tipton by more closely matching according to pre-selected criteria,” the Examiner has failed to

point to any teaching, motivation, or suggestion as to how such a general desire would lead to the specific combination of the inventory management system of Tipton with the waste management system of Embutsu. In fact, Tipton teaches an inventory management system that includes a contact management function which “includes contact personnel for any company that a division or department relies on for handling the disposal of their toxic waste.” (Tipton, col. 49, ll. 49-51) The time and expense of the extensive modifications that would be required to add the capability to identify hazardous waste handlers based on pre-selected criteria to the system of Tipton would be prohibitive given that the Tipton system is designed to allow a user to identify their appropriate hazardous waste handlers by the much simpler method of a contact management database.

Furthermore, no one skilled in the art would modify the inventory system of Tipton to include the waste management system of Embutsu since the system of Embutsu is a requirements-based planning system driven by waste processor demand and not waste producer output. Both the CCPA and the Federal Circuit have consistently held that when an obviousness rejection is based upon a combination or modification of a reference that destroys the intent, purpose, or function of the invention disclosed in the reference, such a proposed combination or modification is not proper and a *prima facie* case of obviousness cannot be made (see, e.g., *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984)). In this case, the system of Embutsu is designed to “feed waste continuously and stably to [a] recycling facility (i.e., controlling operation to ensure that a steady or substantially constant supply of recycled items are available or are being processed within the recycling system to supply consumer demand without interruption).” (Embutsu, col. 2, ll. 24-29) No one skilled in the art would combine a demand-driven requirements-based recycling management system with the inventory management system

of Tipton to manage waste chemicals. Tipton is not directed to providing waste as an input to a recycling system. To control the inventory by the demand of waste recyclers would destroy the intended function of the Tipton system which functions as an inventory monitoring system.

Because the Examiner has offered only a conclusory, unsupported statement as the legally required teaching, motivation, and suggestion to combine Tipton and Embutsu, and in light of the reasons against such a combination, it appears that the Examiner is using the Applicants' application as a roadmap in developing his rejection. That is, the Examiner appears to be using hindsight reconstruction as a substitute for a factual basis for the rejection of the claims under 35 U.S.C. §103. Such use of hindsight reconstruction is not proper. "There must be a reason apparent at the time the invention was made to a person of ordinary skill in the art for applying the teaching at hand, or the use of the teaching as evidence of obviousness will entail prohibited hindsight." *In re Nomiya, Koshisa, and Matsumura*, 509 F.2d 566, 184 U.S.P.Q. (CCPA 1975). "The Patent Office has the initial duty of supplying a factual basis for a rejection under 35 U.S.C. §103. It may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis." *In re Rice*, 481 F.2d 1316, 178 U.S.P.Q. 478, 479 (CCPA 1973).

(ii) The Proposed Combination Does Not Arrive at the Invention

Even if, for arguments sake, the Examiner had offered a legally sufficient teaching, motivation, or suggestion to combine Tipton and Embutsu, such a combination would not arrive at the invention of claims 22 and 49-50. For example, Tipton does not teach a computer system "configured to associate a set of vendors from the plurality of vendors to provide waste management service for the waste producing entity" as recited in independent claim 22. Tipton

merely teaches a contact management system whereby a user may enter data for a waste management service. There is no disclosure that the Tipton system accesses the stored data to make any association between a vendor of waste management services and a waste producing entity.

The deficiency of Tipton is not cured by Embutsu. The system of Embutsu does not associate any data with any waste producing entity. The system of Embutsu merely considers available waste located at various waste collection sites and models the future availability of waste from the waste collection sites to determine a recycling process plan for a recycling processor. It does not associate the vendor of a waste management service with a waste producing entity. In fact, there is no disclosure in Embutsu for gathering data from a particular waste producing entity, such as a homeowner, for example. At best, the combination of Tipton and Embutsu would result in a waste processor process planning system which considers inventory at a site to predict a volume of waste to be processed in the future. Therefore, the combination of Tipton and Embutsu does not arrive at the invention of claims 22 and 49-50.

(iii) Conclusion regarding claims 22 and 49-50

Based on the above, the Examiner has not established a proper §103 rejection with regard to Appellants' claims 22 and 49-50. As such, the rejection of claims 22 and 49-50 is improper and should be overruled.

B. Claims 23-24, 32 and 27-29 are not Obvious over Tipton and Embutsu

The §103 rejection of claims 23-24, 32 and 27-29 is improper and should be overruled for at least the following reasons:

(i) There is no Legally Sufficient Teaching, Motivation, or Suggestion to Combine the References

The arguments of section A(i) above are reiterated here. Namely, the Examiner has failed to provide a legally sufficient teaching, motivation, or suggestion to combine Tipton and Embutsu.

(ii) The Proposed Combination Does Not Arrive at the Invention

Claims 23-24, 32 and 27-29 each depends from claim 22 and the arguments of section (A)(ii) above are reiterated here. Additionally, the rejection of claims 23-24, 32 and 27-29 is improper based on the arguments presented below.

Tipton does not teach the input of any data associated with processing of waste components produced by the waste producing entity. Tipton merely teaches an inventory status of waste for materials that have been so designated within the inventory system. There is no teaching within Tipton that a waste producing entity input any data related to the processing of waste. The only teaching in Tipton related to waste processing is a contact system of maintaining contact data for waste service vendors. This defect is not cured by Embutsu. Embutsu does not teach any interaction within the system by a waste producing entity. Embutsu only teaches the monitoring of inventory at waste collection sites and the prediction of waste that will be produced in a geographical location. The teaching of Embutsu does not teach any

interaction between a waste producing entity, such as a household, for example, and the waste processor. Thus, there is no teaching of the input of any data associated with processing of waste components produced by the waste producing entity. The rejection of claims 23-24, 32 and 27-29 is improper for at least this reason and should be overruled.

(iii) Conclusion regarding claims 23-24, 32 and 27-29

Based on the above, the Examiner has not established a proper §103 rejection with regard to Appellants' claims 23-24, 32 and 27-29. As such, the rejection of claims 23-24, 32 and 27-29 is improper and should be overruled.

C. Claims 25, 34-35, 39-42, and 51-52 are not Obvious over Tipton and Embutsu

(i) There is no Legally Sufficient Teaching, Motivation, or Suggestion to Combine the References

The arguments of section A(i) above are reiterated here. Namely, the Examiner has failed to provide a legally sufficient teaching, motivation, or suggestion to combine Tipton and Embutsu.

(ii) The Proposed Combination Does Not Arrive at the Invention

Claims 25, 34-35, 39-42 and 51-52 each depend from claim 22 and the arguments of section (A)(ii) above are reiterated here. Additionally, the rejection of claims 23-24, 32 and 27-29 is improper based on the arguments presented below.

Tipton does not teach the creation of waste processing service orders or service requests by a waste producing entity. Further, Tipton does not teach any direct interaction with a vendor

by the inventory system disclosed in Tipton as recited by the claims 25, 34-35, 39-42, and 51-52. This defect is not cured by Embutsu. Embutsu does not teach any interaction within the system by a waste producing entity. Embutsu only teaches the monitoring of inventory at waste collection sites. The teaching of Embutsu does not teach any interaction between the waste producing entity, such as a household, for example, and the waste processor/vendor. At no point, does a waste producing entity interact with the system of Embutsu. Thus, there is no teaching of creation of waste processing service orders or service requests by a waste producing entity. The rejection of claim 25, 34-35, 39-42, and 51-52 over Tipton in view of Embutsu is improper for at least this reason and should be overruled.

(iii) Conclusion regarding claims 25, 34-35, 39-42, and 51-52

Based on the above, the Examiner has not established a proper §103 rejection with regard to Appellants' claims 25, 34-35, 39-42, and 51-52. As such, the rejection of claims 25, 34-35, 39-42, and 51-52 is improper and should be overruled.

D. Claims 26 and 33 are not Obvious over Tipton and Embutsu

The §103 rejection of claims 26 and 33 is improper and should be overruled for at least the following reasons:

(i) There is no Legally Sufficient Teaching, Motivation, or Suggestion to Combine the References

The arguments of section A(i) above are reiterated here. Namely, the Examiner has failed to provide a legally sufficient teaching, motivation, or suggestion to combine Tipton and Embutsu.

(ii) The Proposed Combination Does Not Arrive at the Invention

Claims 26 and 33 each depends from claim 22 and the arguments of section (A)(ii) above are reiterated here. The rejection of claims 26 and 33 is improper on at least that basis and should be overruled. Additionally, claims 26 and 33 are allowable over Tipton and Embutsu based on the arguments presented below.

Tipton does not teach any comparison or analysis with regard to vendors for waste management service for the waste producing entity. Tipton merely teaches a contact system wherein users can input contact information related to various waste processing vendors. Tipton does not teach any selection of vendors within the inventory system of Tipton. This defect is not cured by Embutsu. Embutsu does not teach any comparison or analysis with regard to vendors for waste management service for the waste producing entity. Embutsu teaches the monitoring of inventory at waste collection sites and the prediction of waste that will be produced in a geographical location. The teaching of Embutsu does not teach any interaction between a waste producing entity, such as a household, for example, and the system of Embutsu. Thus, there is no teaching of any comparison or analysis with regard to vendors for waste management service for the waste producing entity. The rejection of claims 26 and 33 over Tipton in view of Embutsu is improper for at least this reason and should be overruled.

(iii) Conclusion regarding claims 26 and 33

Based on the above, the Examiner has not established a proper §103 rejection with regard to Appellants' claims 26 and 33. As such, the rejection of claims 26 and 33 is improper and should be overruled.

E. Claims 30 and 31 are not Obvious over Tipton and Embutsu

The §103 rejection of claims 30 and 31 is improper and should be overruled for at least the following reasons:

(i) There is no Legally Sufficient Teaching, Motivation, or Suggestion to Combine the References

The arguments of section A(i) above are reiterated here. Namely, the Examiner has failed to provide a legally sufficient teaching, motivation, or suggestion to combine Tipton and Embutsu. Assuming, for arguments sake, that independent claim 22 and any intervening claims are obvious over Tipton in view of Embutsu, claims 30 and 31 are still allowable based on the arguments presented below.

In the 10/17/2005 Official Action, the Examiner makes the broad assertion that “[s]cheduling/rescheduling of waste removal is an obvious outcome and benefit of constant monitoring.” This unsupported statement is not legally sufficient to establish a *prima facie* case of obviousness. In fact, the statement by the Examiner is made out-of-context with regard to the claims. The terms “scheduling” and “rescheduling” do not appear in claims 30 and 31. The unsupported statement by the Examiner fails to distinguish the structural differences between

claims 30 and 31. Because the Examiner has offered only a conclusory, unsupported statement as the legally required teaching, motivation, and suggestion the Examiner appears to be using hindsight reconstruction as a substitute for a factual basis for the rejection of the claims 30 and 31 under 35 U.S.C. §103. Such use of hindsight reconstruction is not proper. The rejection of claims 30 and 31 is improper for at least this reason and should be overruled.

(ii) The Proposed Combination Does Not Arrive at the Invention

Claims 30 and 31 depend from claim 22. The arguments of section (A)(ii) are reiterated here and claims 30 and 31 are allowable on at least that basis. Assuming, for arguments sake, that independent claim 22 and any intervening claims are obvious over Tipton in view of Embutsu, claims 30 and 31 are still allowable based on the arguments presented below.

With regard to claims 30 and 31, the Examiner stated “Tipton discloses monitoring inflows and outflows (see at least column 3, lines 1-9), inherently disclosing a sensing device.” (see page 4 of the 10/17/2005 Official Action). The text the Examiner identified is the following passage from Tipton:

1) a central control station that monitors and places a unique identification on the inflow of chemical containers to the station, monitors the storage of chemicals, monitors and places a unique identification on the new chemical containers created by transfer from an original container(s) or by the mixing of chemicals from various stored chemical containers into a new container(s), and monitors the outflow of chemicals from a central station as waste or surplus.
(Tipton, col. 3 ll. 1-9).

In order to find inherency in the prior art, it must be shown that the “missing descriptive matter is necessarily present” and “that it would be so recognized by persons of ordinary skill.” *Continental Can Co. USA Inc. v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991); *In re Oelrich*, 666 F.2d 578, 581 (C.C.P.A. 1981) (quoting *Hansgirg v. Kemmer*, 26 C.C.P.A. 937,

102 F.2d 212, 214 (1939)). Discussing *Continental Can*, the Judge Rader explained in *Schering Corp. v. Geneva Pharmaceuticals*, 339 F. 3d 1373 (Fed. Cir. 2003) that “a prior art reference may anticipate without disclosing a feature of the claimed invention if that missing characteristic is necessarily present, or inherent, in the single anticipating reference.” *Schering* at 1377 (citing *Continental Can Co. USA Inc.* at 1268). Further, the court stated “*Continental Can* stands for the proposition that inherency, like anticipation itself, requires a determination of the meaning of the prior art.” *Schering* at 1377. However, it is not necessary that the inherent feature be recognized at the time of creation of the prior art, only that the scope of the prior art reference be recognizable by those skilled in the art to include the inherent feature. *Id.* at 1378.

The Examiner has improperly asserted inherency in the rejection of claims 30 and 31. A sensor is not “necessarily present, or inherent” in Tipton. A close reading of the Tipton reference in its entirety illuminates that the inventory tracking system of Tipton “monitors inflows and outflows” by the intervention of human users updating inventory information in the database. The information may be gathered manually or by data acquisition tools such as bar code readers, for example. (see generally, Tipton, col. 43, ll. 11-28) As disclosed, the entire inventory system of Tipton operates without the use of any “sensors.” The use of sensors is not necessary to practice the system disclosed in Tipton. Therefore, a sensor is not inherently disclosed in Tipton as asserted by the Examiner. The rejection of claims 30 and 31 is improper for at least this reason and should be overruled.

Further, even if Tipton were to disclose the use of a sensor to monitor inventory, the combination of Tipton and Embutsu would not arrive at the invention recited in claims 30 and 31. Claim 30 includes the limitations of claims 22 and 24 and further recites a “sensor located at the waste producing entity, the sensor monitoring a waste component and generating monitoring

data indicating when the waste producing entity requires waste management service.” Not only does Tipton fail to disclose a “sensor located at the waste producing entity,” Tipton also wholly fails to disclose “the sensor monitoring a waste component and *generating monitoring data indicating when the waste producing entity requires waste management service.*” There is not teaching that inventory data indicates when the waste producing entity requires waste management service. This deficiency is not cured by Embutsu. Embutsu does not disclose the use of a sensor monitoring waste. Thus, the combination of Tipton and Embutsu would not arrive at the invention recited in claims 30 and 31. The rejection of claims 30 and 31 is improper for at least this reason and should be overruled.

(iii) Conclusion regarding claims 30 and 31

Based on the above, the Examiner has not established a proper §103 rejection with regard to Appellants’ claims 30 and 31. As such, the rejection of claims 30 and 31 is improper and should be overruled.

F. Claim 36 is not Obvious over Tipton and Embutsu

The §103 rejection of claim 36 is improper and should be overruled for at least the following reasons:

(i) There is no Legally Sufficient Teaching, Motivation, or Suggestion to Combine the References

The arguments of section A(i) above are reiterated here. Namely, the Examiner has failed to provide a legally sufficient teaching, motivation, or suggestion to combine Tipton and Embutsu.

(ii) The Proposed Combination Does Not Arrive at the Invention

With regard to claim 36, in the Official Action dated 10/17/2005 the Examiner stated “Tipton’s use of databases as disclosed above inherently discloses storage of waste processing data.” (see page 4) To reiterate from the analysis above, “a prior art reference may anticipate without disclosing a feature of the claimed invention if that missing characteristic is necessarily present, or inherent, in the single anticipating reference.” *Schering* at 1377 (citing *Continental Can Co. USA Inc.* at 1268). The assertion of the Examiner that Tipton inherently discloses waste processing data is improper under the *Continental Can Co.* standard. In fact, the assertion by the Examiner does not reflect the structure recited in claim 36.

Claim 36 recites “wherein the first computer system is further configured to store waste component processing data associated with the waste components of the waste producing entity processed by the vendors.” Tipton does not disclose any such structure. As noted above, the inventory management system of Tipton includes a contact management feature which permits a user to maintain data related to a waste processing vendor within the contact management system. Tipton does not disclose any of the structure recited in claim 36. Further, such structure is not necessarily present in the inventory management system of Tipton. Tipton is directed to an inventory management and tracking system. It is not “necessary” that the system of Tipton “store waste component processing data associated with the waste components of the waste producing entity processed by the vendors” as recited in claim 36. This defect is not cured by Embutsu. Embutsu does not disclose storing any data for a waste producing entity (e.g. a household). The rejection of claim 36 is improper for at least this reason and should be overruled.

(iii) Conclusion regarding claims 36

Based on the above, the Examiner has not established a proper §103 rejection with regard to Appellants' claim 36. As such, the rejection of claim 36 is improper and should be overruled.

G. *Claim 37 and 38 are not Obvious over Tipton and Embutsu*

The §103 rejection of claim 37 and 38 is improper and should be overruled for at least the following reasons:

(i) There is no Legally Sufficient Teaching, Motivation, or Suggestion to Combine the References

The arguments of section A(i) above are reiterated here. Namely, the Examiner has failed to provide a legally sufficient teaching, motivation, or suggestion to combine Tipton and Embutsu. Assuming, for arguments sake, that independent claim 22 and any intervening claims are obvious over Tipton in view of Embutsu, claims 37 and 38 are allowable based on the arguments presented below.

In the 10/17/2005 Official Action with regard to claims 37 and 38 the Examiner stated "Tipton discloses report generation as shown above. Generation of financial reports would be an obvious and necessary inclusion." (see page 5) The Examiner wholly fails to identify any factual basis for a legally sufficient teaching, motivation, or suggestion to include financial reports.

The failure of the Examiner to cite any legally sufficient teaching, motivation, or suggestion to include consolidated financial statements results in the rejection of claims 37 and

38 being improper. Once again, it appears that the Examiner is using the Applicants' application as a roadmap in developing his rejection through impermissible hindsight. The rejection of claims 37 and 38 is improper for at least this reason and should be overruled.

(ii) The Proposed Combination Does Not Arrive at the Invention

Claims 37 and 38 depend indirectly from claim 22. The analysis of section (A)(ii) are reiterated here and claims 37 and 38 are allowable on at least that basis. Assuming, for arguments sake, that independent claim 22 and any intervening claims are obvious over Tipton in view of Embutsu, claims 37 and 38 are allowable based on the arguments presented below.

Claims 37 and 38 each recite "wherein the first computer system is further configured generate a consolidated financial statement relating to the waste management services provided by the vendors to the waste producing entity." As noted above, the inventory management system of Tipton includes a contact management feature which permits a user to maintain data related to a waste processing vendor within the contact management system. Tipton does not teach any reports related to waste management vendors. Tipton does not teach any interaction between the inventory system disclosed in Tipton and vendors of waste management services. This deficiency is not cured by Embutsu. Embutsu does not disclose any relationship between a waste processor and a waste producing entity. As has been reiterated multiple times, Embutsu is a system for process planning for a waste processor or processors. There is no relationship between the waste producing entity (e.g. a household) and a waste processor disclosed in Embutsu. The waste processor does not provide waste management service to the waste producing entity of Embutsu. Therefore, there is no need for any report related to the waste producing entity to be generated. Thus, the combination of Tipton and Embutsu would not

arrive at the invention recited in claims 30-31. The Examiner's assertion that the creation of financial reports is obvious is without factual support. Further, the assertion completely discounts the recited structure of claims 37 and 38. The rejection of claim 37 and 38 is improper for at least this reason and should be overruled.

(iii) Conclusion regarding claims 37 and 38

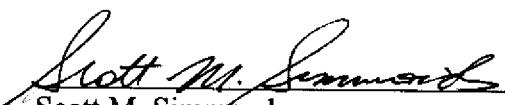
Based on the above, the Examiner has not established a proper §103 rejection with regard to Appellants' claims 37 and 38. As such, the rejection of claims 37 and 38 is improper and should be overruled.

II. Summary Conclusions

Accordingly, it is submitted that the 35 U.S.C. §103 rejection of claims 22-42 and 49-52 is erroneous. The Board is thus urged to reverse the rejection. Such action is respectfully requested.

Respectfully submitted,

BARNES & THORNBURG LLP



Scott M. Simmonds
Reg. No. 55620

Indianapolis, Indiana
Tel: 317-231-7403
Fax: 317-231-7433
Email: scott.simmonds@btlaw.com
INDS0287458v1

CLAIMS APPENDIX

22. A waste management system, comprising:

a computer storage medium storing waste management data associated with a plurality of vendors having waste management capabilities and providing waste management services and entity profile data associated with a plurality of waste producing entities having waste processing requirements and producing waste components; and

a first computer system configured to access the computer storage medium and stored waste management data and entity profile data, and further configured to associate a set of vendors from the plurality of vendors to provide waste management service for the waste producing entity.

23. The system of claim 22, further comprising a second computer system configured to transmit to and receive information from the first computer system, the second computer system configured to provide an interface wherein the waste producing entity inputs and receives data associated with the waste processing of waste components produced by the waste producing entity.

24. The system of claim 23, further comprising a plurality of third computer systems, each of the third computer systems configured to transmit to and receive information from the first computer system, each of the third computer systems corresponding to each of the vendors, and configured to provide an interface wherein each of the vendors inputs and receives data associated with the waste processing of waste components produced by the waste producing entity.

25. The system of claim 24, wherein a waste service network includes the plurality of vendors, and wherein the waste producing entity inputs a waste processing service order into the second computer system, and wherein the first computer system is further configured to receive the waste processing service order from the second computer system and provide the waste processing service order to one of the third computer systems corresponding to one of the vendors associated with the set of vendors.

26. The system of claim 22, wherein the set of vendors from the plurality of vendors to provide waste management service for the waste producing entity is determined by comparing the waste management data to the entity profile data and selecting a set of vendors from the plurality of vendors to provide waste management service for the waste producing entity based on the comparison.

27. The system of claim 24, wherein the first computer system is further configured to store waste component processing data associated with the waste components of the waste producing entity processed by the vendors.

28. The system of claim 27, wherein the second computer system is further configured to generate reports relating to the waste processing of the waste components produced by the waste producing entity.

29. The system of claim 28, wherein the first computer system is further configured to store regulatory data relating to waste processing and waste components, and wherein the second computer system is further configured to generate regulatory reports relating to the waste processing of the waste components produced by the waste producing entity.

30. The system of claim 24, further comprising: a sensor located at the waste producing entity, the sensor monitoring a waste component and generating monitoring data indicating when the waste producing entity requires waste management service; wherein the first computer system is configured to receive the monitoring data and place a service request to a first vendor from the set of vendors to provide waste management service for the waste producing entity when the monitoring data indicates the waste producing entity requires waste management service.

31. The system of claim 30, wherein the first computer system is further configured to withdraw the request from the first vendor if the first vendor does not respond within a period of time and further configured to place a service request to a second vendor from the set of vendors to provide waste management service for the waste producing entity when the monitoring data indicates the waste producing entity requires waste management service.

32. The system of claim 24, wherein the entity profile data includes a plurality of items, each item corresponding to a waste processing requirement of the waste producing entity.

33. The system of claim 32, wherein the first computer system is configured to associate a set of vendors from the plurality of vendors to provide waste management service for the waste producing entity for each item.

34. The system of claim 33, wherein the first computer system is configured to receive a service request for an item from the waste producing entity, and place a service request to a first vendor from the set of vendors to provide waste management service for the item.

35. The system of claim 34, wherein the first computer system is further configured to withdrawing the request from the first vendor if the first vendor does not respond within a period of time and place a service request to a second vendor from the set of vendors to provide waste management service for the item.

36. The system of claim 35, wherein the first computer system is further configured to store waste component processing data associated with the waste components of the waste producing entity processed by the vendors.

37. The system of claim 36, wherein the first computer system is further configured generate a consolidated financial statement relating to the waste management services provided by the vendors to the waste producing entity.

38. The system of claim 27, wherein the first computer system is further configured generate a consolidated financial statement relating to the waste management services provided by the vendors to the waste producing entity.

39. A waste management method, the method comprising the steps of:
creating a service network including a plurality of waste processing vendors;
evaluating the waste processing capabilities of each of the waste processing vendors in
the service network;
receiving a waste processing service request from a waste producing entity;
comparing the waste processing service request to the capabilities of the waste processing
vendors in the service network; and
selecting a vendor from the service network to fulfill the waste processing service
request.

40. The method of claim 39, further comprising the steps of: evaluating the
performance of each of the waste processing vendors in the service network; and reevaluating the
waste processing capabilities of a vendor in the service network based on the performance of the
vendor.

41. The method of claim 39, further comprising the steps of: evaluating waste
processing requirements of a waste producing entity; minimizing the waste processing
requirements of the waste producing entity; and selecting a preferred set of vendors from the
service network to provide service to the waste producing entity based on the minimized waste
processing requirements of the waste producing entity.

42. The method of claim 39, further comprising the steps of: evaluating waste
processing requirements of a waste producing entity; minimizing the waste processing costs of

the waste producing entity; and selecting a preferred set of vendors from the service network to provide service to the waste producing entity based on the minimized waste processing costs of the waste producing entity.

49. The system of claim 22, wherein the waste management services include at least one of processing hazardous waste, processing industrial waste, disposing of refuse, recycling plastics, and recycling cardboard.

50. The system of claim 22, wherein the waste components include at least one of hazardous waste, industrial waste, refuse, recyclable plastics, and recyclable cardboard.

51. The method of claim 39, wherein the waste processing capabilities include at least one of processing hazardous waste, processing industrial waste, disposing of refuse, recycling plastics, and recycling cardboard.

52. The method of claim 39, wherein the waste producing entity produces at least one of hazardous waste, industrial waste, refuse, recyclable plastics, and recyclable cardboard.

EVIDENCE APPENDIX

Nothing is included with this appendix.

RELATED PROCEEDINGS APPENDIX

Nothing is included with this appendix.